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EXAMINER

PHUONG, DAI

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

A. Claims 1, 6, 8-12, 14-18, 20, 35, 51, 53-62, and 71 are Nonobvious.

Applicant, on page 3 of the remark, argues that the combination of Picciallo fail to teach the claimed feature, e.g., without dividing said reserved portion into a plurality of parts between said plurality of services. However, the Examiner respectfully disagrees.

Picciallo discloses in col. 12, lines 1-14 that the system allocates an amount of promotional fund (reserved portion of the promotional fund) for a plurality of services (food and game). In other words, the amount of promotional fund is reserved for general spending of food and game; and without dividing the amount of promotional fund to the individual services. For example, if the amount of promotional fund is \$100 and then it reserves for both food and game. Therefore, the Examiner contend the combination of references show all limitations in the claim.

Applicant, on page 3 of the remark, argues that Picciallo does not describe a situation where a limit is set such that meals and blackjack contribute to the same limit and all of the funds under the limit could be exhausted on, for example, only meals. This contrasts with the recitation of the independent claims, which indicates that the reserve portion is not divided into a plurality of parts between services. However, the Examiner respectfully disagrees.

Firstly, as mentioned above, Picciallo discloses in col. 12, lines 1-14 that the amount of promotional fund is reserved for general spending of food and game; and without dividing the amount of promotional fund to the individual services.

Secondly, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant

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relies (i.e., where a limit is set such that meals and blackjack contribute to the same limit and all of the funds under the limit could be exhausted on, for example, only meals) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant, on page 4 of the remark, argues that Picciallo does not employ a concept that correlates to the "reserve portion." Recall that the reserve portion of the claims is an amount that is set aside from the user's money for the purpose of funding services as the services are being used. Picciallo does not include disclosure of a reserve portion. However, the Examiner respectfully disagrees.

Firstly, Pincus and Masuda disclose the system reserves a portion of an account for service (see Pincus and Masuda teach that at paragraph 28 and 49 respectively). Additionally, Picciallo discloses in col. 12, lines 1-14 that the system allocates an amount of promotional fund (reserved portion of the promotional fund) for a plurality of services (food and game). For the reason above, the Examiner contend that Pincus, Masuda and Picciallo teach "reserve portion".

Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant, on page 4 of the remark, argues that if Picadillo does disclose the feature for which it is relied upon, i.e., not generating predefined divisions of funds within a reserved amount, then the references are contradictory and one of skill in the art would not combine the references for this purpose. As such, for this additional reason Picciallo is incompatible with the other references of the cited combination, and Picciallo does not disclose the feature that the Office Action relies upon for constructing the cited combination. However, the Examiner respectfully disagrees.

In response to applicant's argument that Picciallo is incompatible with the other references of the cited combination, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant, on page 5 of the remark, argues that Picciallo cannot be combined with Masuda and Pincus, because Picciallo is directed to a solution involving the use of magnetic cards, which is not contemplated in either of Masuda or Pincus. Therefore, it would not be obvious to combine the concepts disclosed and relied upon by the Office Action. At column 3, lines 14-23, Picciallo describes the aspect of third-party recipients, designated by account holders, being issued magnetic cards to access funds. These third-party recipients can then withdraw the funds as cash from an ATM or make point-of-sale purchases of goods and services by electronic fund transfer. Additionally, at column 3, lines 28-30, Picciallo describes the use of magnetic cards by the third-party. Since the

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description of Picciallo is directed to magnetic card solutions and Masuda and Pincus are directed to wireless communications solutions, the references cannot be said to be from the same technical field. While bodily incorporation of the references into a homogenous solution is not the absolute test for combination, incompatibilities between technologies do provide a basis for determining whether one of ordinary skill in the art would consider the references in combination without relying upon improper hindsight. In this situation, none of Picciallo, Masuda, or Pincus provide any indication that one of skill in the art would consider the references in the aggregate given the clear discrepancies in the technical solutions being offered by the references. However, the Examiner respectfully disagrees.

In response to applicant's argument that Picciallo cannot be combined with Masuda and Pincus, because Picciallo is directed to a solution involving the use of magnetic cards, which is not contemplated in either of Masuda or Pincus, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that since the description of Picciallo is directed to magnetic card solutions and Masuda and Pincus are directed to wireless communications solutions, the references cannot be said to be from the same technical field, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test

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is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

B. Claims 21, 24, 25, 28, 29, 32-34, 37, 63-66, 68-70, and 72 are Nonobvious.

Applicant, on page 5 of the remark, argues that the combination of Pincus, Masuda, and Ephraim fails to teach or suggest, at least, "a controller configured to control an allocation of said monetary amount between a plurality of services to be accessed simultaneously by a user device," as recited in independent claim 21, and similarly recited in independent claims 37 and 72. Applicants respectfully submit that independent claim 21 recites "an allocation of said monetary amount," where "said monetary amount" refers back to a monetary amount that has been converted from information defining an amount of a reserved portion in a form other than a monetary amount. Independent claims 37 and 72 recite similar limitations. However, the Examiner respectfully disagrees.

Firstly, Masuda discloses in paragraph 49 and 50 that if the balance allotted to the voice service when a service request for packet communication is made is .Yen.1000,

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.Yen.500 is allotted to each of the voice and packet services, and the two services are then executed in accordance with their respective allotments. In other words, a controller configured to control an allocation of said monetary amount (.Yen.1000) between a plurality of services (voice and data packet services) to be accessed simultaneously by a user device. Additionally, Masuda discloses in paragraph 39 that the system allocates the reserved portion of the account to a plurality of prepaid services to be conducted simultaneously.

Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant, on page 6 of the remark, argues that Ephraim explicitly states that the conversion is done for the purpose of debiting the account of the user, and not for the purpose of allocating a reserved portion between a plurality of services. In this regard, Ephraim does not disclose operations with respect to a reserved portion, as recited in the claims. Thus, Ephraim also fails to disclose, or suggest, allocating a monetary amount which has been converted from information defining an amount of a reserved portion in a form other than a monetary amount. However, the Examiner respectfully disagrees.

Firstly, in response to applicant's argument that Ephraim explicitly states that the conversion is done for the purpose of debiting the account of the user, and not for the

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purpose of allocating a reserved portion between a plurality of services, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

C. Claims 31 and 67 are Nonobvious.

Applicant, on page 6 of the remark, argues that Claims 31 and 67 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pincus, Ephraim, and Masuda in further view of U.S. Patent Publication No. 2004/0148384 to Ramakrishnan. However, the cited combination relies upon Ephraim for disclosing the same features as described above with respect to the rejection of independent claims 21 and 37, for which claims 31 and 67 depend, respectively. Since Ephraim fails in this regard, and Ramakrishnan does not cure the deficiencies of Ephraim (nor is Ramakrishnan cited for this purpose), dependent claims 31 and 67 are patentable over the cited combination due at least to the failures of Ephraim. The rejections of claims 31 and 67 are therefore overcome. However, the Examiner respectfully disagrees.

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In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

D. Claims 3, 7, 48, 52, 75, and 76 are Nonobvious.

Applicant, on page 7 of the remark, argues that Claims 3, 7, 48, 52, 75, and 76 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pincus and Masuda in further view of U.S. Patent No. 7,162,220 to Hanson. Dependent claims 3, 7, 48, and 52 are patentable for the same reasons as their respective independent claims described above, because Hanson does not cure the deficiencies of Pincus and Masuda, nor is Hanson cited for that purpose for rejecting the respective independent claims. The cited combination of Pincus, Masuda, and Hanson also fails to teach or suggest all of the elements of independent claims 75 and 76 and the claimed invention in this regard is also not an obvious variant of the cited combination. However, the Examiner respectfully disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant, on page 7 of the remark, argues that independent claim 75, and similarly independent claim 76, recites, " after the request is made, divide said reserved

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portion into a plurality of parts between said plurality of services, and reallocate a remainder of said reserved portion between said plurality of services when at least one of said plurality of services uses up its part of said reserved portion." Applicants respectfully submit that the combination of Pincus, Masuda, and Hanson fails to disclose, or suggest, the aforementioned feature. However, the Examiner respectfully disagrees.

Masuda discloses in paragraph 50 that if the balance allotted to the voice service when a service request for packet communication is made is .Yen.1000, .Yen.500 is allotted to each of the voice and packet services, and the two services are then executed in accordance with their respective allotments. In other words, Masuda discloses the balance divides said reserved portion into a plurality of parts between a plurality of services (voice and data packet services). Furthermore, Masuda discloses in paragraph 51 that the balance is reallocated also when one or more services are disconnected while a plurality of prepaid services are executed. Let it be assumed that while voice and packet services are executed, the voice service is disconnected. But, Masuda does not expressly teach that when one or more services are disconnected because of the account balance reaches to zero or uses up its account reserved balance. On the other hand, Hanson discloses when one or more services are disconnected because of the account balance reaches to zero or uses up its account reserved balance. Therefore, the Examiner contends that the combined of references show all limitations in the claim.

Applicant, on page 7 of the remark, argues that the Office Action now cites to Hanson to cure the deficiencies of Pincus and Masuda. However, Hanson does not cure

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the deficiencies of Pincus and Masuda. Hanson is merely directed to the use of a maximum allowable call timer that is part of a pre-paid account. The Office Action fails to appreciate that the "using up" of a part of the reserved portion for a particular service is a triggering event for reallocating the remainder as recited in the claims. Hanson fails to provide disclosure indicating that reallocation, as allegedly disclosed in Masuda, would be triggered by the expiration of the timer of Hanson. Neither Hanson nor Masuda discloses this causal relationship, and therefore the cited combination fails to render claims obvious. However, the Examiner respectfully disagrees.

As mentioned above, Masuda discloses in paragraph 51 that the balance is reallocated also when one or more services are disconnected while a plurality of prepaid services are executed. Let it be assumed that while voice and packet services are executed, the voice service is disconnected. But, Masuda does not expressly teach that when one or more services are disconnected because of the account balance reaches to zero or uses up its account reserved balance. On the other hand, Hanson discloses when one or more services are disconnected because of the account balance reaches to zero or uses up its account reserved balance. Therefore, the Examiner contends that the combined of references show all limitations in the claim.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

